

Remarks

By this amendment, the following paragraphs were amended to remove hyperlinks: (1) paragraph beginning at page 5, line 12; (2) paragraph beginning at page 11, line 14; (3) paragraph beginning at page 32, line 26; (4) paragraph beginning at page 35, line 4; and (5) paragraph beginning at page 37, line 23. Claim 1 has also been amended. Support for the claim amendment may be found throughout the specification, including at least page 1, lines 6-9, page 7, lines 13-16, page 15, lines 11-18 and Example 5.

After entry of this amendment, **claims 1-3, 5-13 and 22-24 are pending in the application, claims 8 and 22-24 being withdrawn.** No new matter is introduced by the foregoing amendments. Consideration and allowance of the pending claims are requested.

Objections to the Specification

The disclosure is objected to for containing an embedded hyperlink and/or other form of browser-executable code. As requested, Applicants have amended the specification to remove embedded hyperlinks. Applicants believe these amendments obviate the pending objections and request their withdrawal.

Rejections under 35 U.S.C. §102(b)

Claims 1-3, 5-7 and 9-13 are rejected under 35 U.S.C. §102(b), as allegedly anticipated by Kononen *et al.* (*Nature Medicine*, Vol. 7 (4): 844-847, 1998; hereinafter Kononen *et al.*). Applicants respectfully traverse this rejection for at least the following reasons.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)).

Presently, the Office has failed to satisfy the criteria for an anticipation rejection as set forth by *W.L. Gore & Assocs. or Lindemann Maschinenfabrik GMBH*, particularly with regard to the claims now pending in the case. Although the Office cites multiple pages within Kononen *et al.* to support the pending rejection, nowhere do Kononen *et al.* disclose, suggest or teach a method of analyzing the transcriptome of a tissue section comprising “sequestering molecules corresponding to a specific region or cell type of the tissue section in an aqueous solution contained within at least one of the plurality of grids or plurality of wells, thereby preserving the 2-dimensional architecture of the these molecules relative to other molecules present within the tissue section while simultaneously allowing molecule manipulation in the aqueous solution,” as presently claimed. In contrast, the method provided by Kononen *et al.* only allows for the manipulation of tissue biomolecules that are bound to a surface. See, for example, Figure 1 and legend where an adhesive-coated tape sectioning system is used. The aqueous environment provided by the disclosed method facilitates a number of molecular reactions that will not occur with bound molecules such as bound mRNA, DNA or proteins. Kononen *et al.* do not disclose each and every element of the claimed invention, particularly not as arranged in the claim. Therefore, the teachings of Kononen *et al.* are insufficient to establish anticipation because each and every element of the claimed invention are not revealed or noted in the reference.

In view of the above arguments, and the amendments made herewith, Applicants request withdrawal of the rejections under §102(b).

Request for Rejoinder

Applicants thank the Office for recognizing that claim 1 is a generic claim (Restriction Requirement, November 29, 2006). Applicants believe that the pending claims are in condition for allowance. Thus, Applicants request that withdrawn claims be rejoined as provided by 37 C.F.R. 1.141, which states that upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which depend from or otherwise include all the limitations of an allowable generic claim.

Conclusion

Applicants respectfully submit that the claims submitted herewith are in condition for allowance. If any issues impede the issuance of a notice of allowance, Applicants expressly request that the Examiner contact the undersigned prior to the mailing of a subsequent action in order to arrange a telephone interview. It is believed that a brief discussion of the merits of the present application may expedite prosecution and allowance of the claims.

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